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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,870	11/04/1999	WILLIAM D. HUSE	P-IX-3458	4474

23535 7590 11/07/2003

MEDLEN & CARROLL, LLP  
101 HOWARD STREET  
SUITE 350  
SAN FRANCISCO, CA 94105

EXAMINER

HELMS, LARRY RONALD

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 11/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/434,870

Applicant(s)

HUSE ET AL.

Examiner

Larry R. Helms

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 42-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 42-71 are pending.
2. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.
3. The following Office Action contains NEW GROUNDS of rejection.

### ***Response to Arguments***

4. The rejection of claims 42, 44-47, 49-52, 54-57, 59-62, 64-67, 69-71 under 35 U.S.C. 102(e) as being anticipated by Aruffo et al (U.S. Patent 6,312,693, filed 2/1999) is maintained.

The response filed 7/31/03 has been carefully considered but is deemed not to be persuasive. The response states that in view of the attached 131 declaration of Dr. Watkins the 102(e) and (assuming the 103(a)) rejection must be withdrawn. The declaration of Dr. Watkins has been carefully considered but is deemed not to be persuasive. The declaration is not signed by all of the inventors and does not state that the work was performed in the US. In addition, the declaration states that Dr. Watkins performed the work of the overlapping oligonucleotides and cites evidence in the comparison between various pages in the application and the patent of Aruffo. In response to this argument, it is unclear what providing evidence only for the oligo work antedates the reference. In addition, it is now unclear due to the statement in the declaration that Dr. Watkins invented the oligo work what the contributions of the other

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two inventors, Dr. Huse and Dr. Wu were. Moreover, the declaration brings into question the contribution of the others named on the Arruffo patent. The claims are to heavy and light chains that were made by the instantly claimed method. Were any of the inventors named on the Arruffo patent also inventors on the instant claims? What are there contributions? The declaration is not persuasive and the rejection stands.

5. The rejection of claims 42-71 under 35 U.S.C. 103(a) as being unpatentable over Aruffo et al (U.S. Patent 6,312,693, filed 2/99) as applied to claims 42, 44-47, 49-52, 54-57, 59-62, 64-67, 69-71 above, and further in view of Hagiwara et al (U.S. Patent 5,589,573, issued 12/96) is maintained.

The response filed 7/31/03 has been carefully considered but is deemed not to be persuasive. The response is addressed above in the 102(e) rejection of Aruffo. The same response above to the 102(e) rejection is applicable and made in this rejection.

***The following is a NEW GROUND of rejection***

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(f) he did not himself invent the subject matter sought to be patented.

7. Claims 42-71 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

Because of the declaration filed 7/31/03 by Dr. Watkins stating that he performed the work of the overlapping oligonucleotides and cites evidence in the comparison between various pages in the application and the patent of Arruffo, it is now unclear due to the statement in the declaration that Dr. Watkins invented the oligo work what the contributions of the other two inventors, Dr. Huse and Dr. Wu were. Moreover, the declaration brings into question the contribution of the others named on the Arruffo patent. The claims are to heavy and light chains that were made by the instantly claimed method. Were any of the inventors named on the Arruffo patent also inventors on the instant claims? What are their contributions? It is requested that the contributions of all inventors and those named on the Arruffo patent be explained.

### ***Conclusion***

8. No claim is allowed.
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (703) 306-5879. The examiner can normally be reached on Monday through Friday from 7:00 am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

11. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242.

Respectfully,

Larry R. Helms Ph.D.

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703-306-5879

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A handwritten signature in black ink, appearing to read 'L. Helms', written over a circular stamp.

LARRY R. HELMS, PH.D  
PRIMARY EXAMINER